



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/077,194 12/04/98 BOHN

M 02481.1596

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EXAMINER

KIM, V

ART UNIT

PAPER NUMBER

1614
DATE MAILED:

119
12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Docketed 12/8/00
Case 2481.1596 Attorney OPE/ARJ/JZS
Due Date 3/5/01 w/EX
Action Response Due
By K. J. J. **RECEIVED**

DEC 08 2000

FINNEGAN, HENDERSON,
FARABOW, GARRETT & DUNNER, LLP.

DEC 8 2000

Office Action Summary

Application No.

09/077,194

Applicant(s)

BOHN ET AL.

Examiner

Vickie Y. Kim

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on September 28, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/077,194 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 41-43, 50, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimasa et al (1988).

The claims read on a method of treating seborrheic dermatitis using 1-hydroxy-2-pyridone of formula I in the form of various formulation such as a shampoo.

Yashimasa et al teach piroctone olamine that is 1-hydroxy-4-methyl-6-(2,4,4-trimethylpentyl)-2(1h)pyridone as a effective agent for inhibiting P. ovale that is responsible for seborrheic dermatitis, dandruff and itching. All the critical components are anticipated by this. Thus the claimed subject matter are not patenetably distinct over the prior art.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 38-40, 44-49, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lohaus or Dittmar in view of Yoshimasa et al.

As stated in prior office action, the claimed composition was taught in those patented references. See full text. They also teach the patented composition is effectively used in treatment of dandruff. They also teach antimycotic activities against fungi and yeasts that affect both the skin and the mucous membrane; see Lohaus(US'409)-column 6, lines 45-55 and claims 11-12. The method of preparing analogs of 1-hydroxy-2 pyridones are disclosed, and the claimed derivatives are also well taught and included in these patented references.

Applicant's claims differ because they require seborrheic dermatitis.

It would have been obvious to one of ordinary skill in the art to apply this patented or claimed formula to treat seborrheic dermatitis when either Lohaus or Dittmar's teaching is taken in view of Yoshimasa et al. because Yoshimasa et al teach piroctone olamine (1-hydroxy-4-methyl-6-(2,4,4-trimethylpentyl)-2(1h)pyridone) which is one of derivatives claimed, as a effective agent for inhibiting *P. ovale* that is responsible for seborrheic dermatitis , dandruff and itching.

It would have been motivated to extend the patented method to include seborrheic dermatitis because the patented composition have several advantages compare to other agents because they have not only excellent antimycotic properties(e.g. fungistasis, fungicidal activity)along with antidandruff activities(e.g. effective for inflammation), but also they don't have any considerable side effects nor toxicities.

Response to Arguments


6. Applicant's arguments filed July 19, 2000 have been fully considered but they are not persuasive.

As applicant acknowledged in the response filed July 19, 2000, applicant aware piroctone olamine is effective against P. Ovale that is responsible for seborrheic dermatitis and dandruff, where Yoshimasa et al also stated that hinokitiol has better efficacy against the said yeast. It is very clear that the efficacy of the claimed compound against P. Ovale has been taught in this reference. Therefore, the claimed subject matter is not patentably distinct and remained as rejected.

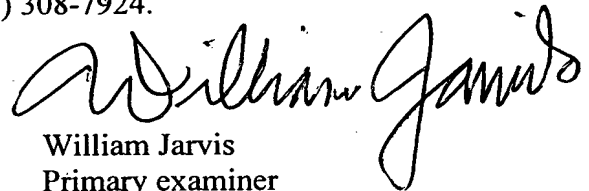
Conclusion

This is a CPA of applicant's earlier Application No. 09/077,194.

7. All the claims are remained as rejected.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is (703) 305-1675 (Monday-Thursday: 7AM-6PM) and Fax number is (703) 308-7924.



Vickie Kim,
Patent examiner
December 1, 2000



William Jarvis
Primary examiner
Art unit 1614